

REMARKS/ARGUMENTS

Favorable reconsideration of this Application, as presently amended and in light of the following discussion, is respectfully requested.

This Amendment is in response to the Office Action mailed on December 29, 2004. Claims 1-25 are pending in the Application and Claims 1-14 stand rejected. New Claims 15-25 are added by the present Amendment.

In the outstanding Office Action, the Abstract of the disclosure was objected to under 37 C.F.R. § 1.52; the Specification was objected to because of an informality; the Information Disclosure Statement, or IDS, filed on October 20, 2003 was asserted as failing to comply with 37 C.F.R. § 1.98(a)(3); Claims 1, 2, 4-7, 10, 12, and 13 were rejected under 35 U.S.C. § 102(b) as being anticipated by Mehr-Ayin et al. (U.S. Patent No. 5,146,172, hereinafter "Mehr-Ayin"); and Claims 3, 8, 11 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mehr-Ayin in view of Moore (U.S. Patent No. 4,787,053, hereinafter "Moore").

In reply to the objections to Applicants' Specification, a replacement Abstract and amendment to several paragraphs in the Specification are submitted. Reconsideration of the objections to Applicants' Specification is respectfully requested.

As to the assertion that the IDS filed on October 20, 2003 is defective, Applicants respectfully disagree. The references enclosed in that IDS were cited on a search report or action of a foreign patent office; therefore, the requirement for a concise explanation of relevance was satisfied by the submission of an English-version of the search report or action which indicates the degree of relevance found by the foreign office. As clearly explained in the MPEP, this information may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an "X", "Y", or "A" indication on

a search report.¹ Based on the foregoing, Applicants respectfully request a full and proper acknowledgement of the IDS filed on October 20, 2003.

With regard to the anticipation rejection, Applicants respectfully submit that Claims 1, 2, 4-7, 10, 12, and 13 are not anticipated by Mehr-Ayin because each and every element as set forth in those claims is not found, either expressly or inherently described, in the cited reference. In an anticipation rejection, the identical invention must be shown in as complete detail as is contained in the claims.²

The appliance recited in Claim 1 comprises, among other features, a display device that displays information contained in an engine identification connector, which is decoded by the recited processor means.

Mehr-Ayin discloses a device to identify a turbine engine with a numeric identity that comprises, as illustrated in FIG. 1 of Mehr-Ayin, a microprocessor 42, an analog-to-digital converter 40, a voltage source 44, and a plurality of resistors, capacitors, and diodes forming an electronic circuit. When an identification module is connected to this electrical circuit, voltage potential measurements at points between resistors of known magnitude and the corresponding resistive identification circuits by the analog-to-digital converter 40 allow the determination of the resistance values of the different resistors in the module by the microprocessor 42. Furthermore, the engine identification modules in Mehr-Ayin are

¹ "Where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office. This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an "X", "Y", or "A" indication on a search report." MPEP § 609(III)(A (3)).

² See MPEP 2131: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," (Citations omitted) (emphasis added). See also MPEP 2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art."

permanently attached to the engines,³ thus they cannot be removable identification connectors as recited in new Claims 19 and 20.

The outstanding Office Action asserts that Mehr-Ayin discloses a display at col. 9, lines 44-49 and at col. 10, lines 43-47. Applicants respectfully disagree. These cited sections of Mehr-Ayin discuss the analog-to-digital converter and a step function 62 used in the conversion of a calculated count to an integer for the purpose of determining the stored value in the module to be identified, respectively. Neither of the cited sections of Mehr-Ayin teaches or discloses a display device. In fact, Applicants respectfully submit that Mehr-Ayin is silent as to the use or incorporation of a display device in the apparatus disclosed.

Applicants respectfully submit that Claim 1 is not anticipated by Mehr-Ayin. This cited prior art reference does not disclose the display device recited in Claim 1. In addition, Claims 2, 4-7, 10, 12, and 13 should be allowed, among other reasons, as depending either directly or indirectly from Claim 1, which should be allowed as just explained.

In addition, Applicants respectfully submit that Claims 7, 9, 10, 12, and 13 are not anticipated by Mehr-Ayin on their own individual merits.

As to Claim 7, Mehr-Ayin is silent to any detection of the model of identification connector that is connected to the disclosed engine identification system. Col. 10, lines 47-52 in Mehr-Ayin discusses transformation of integer values into hexadecimal digits and not the detection of the model of the identification module being identified.

As to Claim 9, Mehr-Ayin is silent as to the provision of at least one protection connector containing an autotest circuit. The section at col. 6, lines 66 – col. 7, line 4 in Mehr-Ayin is related to the function of the analog-to-digital converter 40 and not to any protection connector containing an autotest circuit. This same section of Mehr-Ayin, cited in support of the anticipation rejection of Claims 10 and 12 is silent as to software means for

³ Meyer-Ayin, col. 11, lines 46-49.

testing any reader appliance from an autotest circuit of a protection connector (Claim 10) and to software means for automatically causing the result of a test of a reader appliance to be displayed (Claim 12).

Finally, as to Claim 13, col. 4, lines 17-20 in Mehr-Ayin disclose that when the engine having the disclosed engine identification system is connected to an external system, that external system could then read the identification number from the module to which it is electrically connected. Clearly such a disclosure is silent as to the feature recited in Claim 13, which is an engine identification appliance comprising means for updating a processor.

Based on the foregoing remarks, therefore, Applicants respectfully request that the anticipation of Claims 1, 2, 4-7, 10, 12, and 13 under 35 U.S.C. §102(b) be withdrawn.

As to the obviousness rejection of Claims 3, 8, 11, and 14, Applicants respectfully submit that Mehr-Ayin and Moore, neither individually nor in any combination thereof, support a *prima facie* case of obviousness of the invention recited in Claim 1. This is so for at least two reasons. First, even when combined, these references do not teach or suggest all the claimed features. Secondly, there is no motivation to combine the references except by the use of impermissible hindsight, using Applicants' claims as a blueprint, to pick and choose unrelated elements in Moore to modify Mehr-Ayin in order to deprecate Applicants' claimed invention.

The outstanding Office Action acknowledges that Mehr-Ayin fails to disclose the control members recited in Claim 3, software means for testing the parity of the encoding circuit recited in Claim 8, and the self-contained power supply means of Claim 14. Moore is cited as remedying these deficiencies. However, Moore does not remedy the above-noted deficiencies of Mehr-Ayin with respect to Claim 1; therefore, the resulting combination of Moore and Mehr-Ayin cannot make obvious the invention of Claims 3, 8, and 11, which depend from Claim 1 and incorporate by reference all of the features recited therein.

Moore discloses an engine monitor recorder that records engine and outside air temperature; torque; engine speed; vibration; altitude and airspeed data; data relative to the operation of the aircraft above pre-defined limits of temperature, torque, and speed; over-limits levels and the total time during which the engine is operated within each of the over-limits bands; and the number of starts, power cycles, and the total running time of the engine.⁴ Applicants respectfully submit that there is no sufficient evidence of record for the required motivation to modify the Mehr-Ayin device by incorporating Moore's components therein, for the following reasons.⁵

The outstanding Office Action states that the proposed modification would have been obvious because one of ordinary skill in the art would recognize the desirability for the proposed modifications in order to efficiently and accurately tabulate and display the basic data on an aircraft turbine engine. The record, however, fails to provide the required evidence of a motivation for a person of ordinary skill in the art to perform such modification.

While Moore may provide a reason for efficiently and accurately tabulating and displaying different engine operating parameters, such as temperature, torque, and speed, Moore fails to suggest why a person of ordinary skill in the art would be motivated to incorporate such a feature in the engine identification system disclosed by Mehr-Ayin, which identifies a turbine engine with a numeric identity. Furthermore, the Mehr-Ayin patent states that its structure already achieves the goal of identifying a turbine engine with a numeric identify and does not suggest that further improvement is desired, nor that another feature

⁴ See the Abstract of Moore.

⁵ See MPEP 2143.01 stating "[o]bviousness can only be established by combining or modifying the teaching of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art," (citations omitted). See also MPEP 2144.08 III stating that "[e]xplicit findings on motivation or suggestion to select the claimed invention should also be articulated in order to support a 35 U.S.C. 103 ground of rejection. . . . Conclusory statements of similarity or motivation, without any articulated rational or evidentiary support, do not constitute sufficient factual findings."

should be added to further improve the disclosed engine identification system. In particular, Mehr-Ayin does not suggest the addition of a capability to efficiently and accurately tabulating and displaying several different engine identifications, since, after all, Mehr-Ayin does not suggest the existence or the need to read several identification numbers of a given engine. Thus, Mehr-Ayin and Moore do not provide the motivation to perform the proposed modification of the Mehr-Ayin device. In other words, an attempt to bring in the isolated teaching of Moore's data tabulation and display into the Mehr-Ayin device would amount to improperly picking and choosing features from different references without regard to the teachings of the references as a whole.⁶ While the required evidence of motivation to combine need not come from the applied references themselves, the evidence must come from *somewhere* within the record. In this case, there is nothing in the record supporting the Office Action's proposed modification of the Mehr-Ayin patent.

Based on the above-noted remarks, Applicants respectfully submit that Mehr-Ayin and Moore, neither individually nor in any combination thereof, make obvious the invention recited in Claim 1. In addition, Claims 3, 8, 11, and 13 should be allowed, among other reasons, as depending either directly or indirectly from Claim 1, which should be allowed as just explained. For the foregoing remarks, Applicants respectfully request withdrawal of the rejection of Claims 3, 8, 11, and 13 under 35 U.S.C. § 103(a).

Finally, Applicants have submitted new Claims 15-25, which find non-limiting support on the subject matter originally disclosed as follows: (1) as to Claims 15-17, and 24 in the original claims and FIG. 5 of Applicants' disclosure; (2) as to Claim 16, on page 8, lines 3-12; (3) as to Claim 18, on page 8, lines 27-31; (4) as to Claims 19 and 20, on page 6,

⁶ See In re Ehrreich 590 F2d 902, 200 USPQ 504 (CCPA, 1979) (stating that patentability must be addressed "in terms of what would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the sum of all the relevant teachings in the art, not in view of first one and then another of the isolated teachings in the art," and that one "must consider the entirety of the disclosure made by the references, and avoid combining them indiscriminately.")

lines 24 and d25; (5) as to Claim 21 in FIG. 4; and (6) as to Claims 22, 23, and 25, on page 8, lines 13-20. Therefore, new Claims 15-25 are not believed to raise a question of new matter.⁷

New independent Claim 15 recites an appliance to read an identification connector of an airplane engine, comprising: an identification connector receiver; a processor to decode a plurality of engine information contained in the identification connector; a control device to specify which information from the plurality is decoded by the processor; and a display unit configured to display at least one of the plurality of information about the engine decoded by the processor. New Claims 16-19 and 21-25 depend from Claim 15. New Claim 20 depends from Claim 1. Based on the above-summarized reasons, Applicants respectfully submit that new Claims 15-25 are neither anticipated nor made obvious by Mehr-Ayin and Moore, individually or in any combination.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1-25 is earnestly solicited.

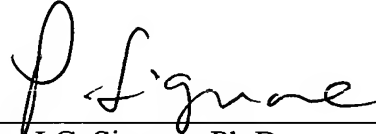
⁷ See MPEP 2163.06 stating that "information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter."

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Reply to Office Action of December 29, 2004

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicants' undersigned representatives at the below listed telephone number.

Respectfully submitted,

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